

Remarks

Applicant gratefully acknowledges withdrawal of the restriction requirement with respect to Group I and Group II. The claims in Group III, claims 47-66, have been withdrawn with prejudice.

Rejections Under 35 U.S.C. § 112

The examiner rejected claims 1-46 and 67-78 as indefinite under 35 U.S.C. § 112, second paragraph, on a number of grounds.

Claims 1-15 have been canceled and new claims 79-113 have been added. Most of the amendments do not narrow the claims. The following chart indicates which of the new claims correspond to which of the original claims:

Original Claim	New Claim
7	79
11	91
15	109
29	110
33	111
34	112
67	113

The new and amended claims are believed to overcome all of the rejections but the rejection to the word "about."

The examiner objected to the term "about" as imprecise. The Board of Patent Appeals addressed the use of the word "about" in *Ex Parte Eastwood, Brindle, and Kolb*, 163 U.S.P.Q. 316 (Bd.Pat.App.1968). According to the Board

the descriptive word "about" is not indefinite as argued by the examiner. Its meaning is not as broad and arbitrary as contended by the examiner. Rather, the term is clear but

flexible and is deemed to be similar in meaning to terms such as "approximately" or "nearly."

Id. at 317. *See also* MPEP 2173.05.A. In the context of amended claims 7-14 and 79-83, which specify that "R³ is selected from the group consisting of tall oil fatty acid residues, aryl groups, alkaryl groups, and aralkyl groups," the use of the word "about" does not render the claims indefinite. With respect to the non-canceled claims 16-78 and new claims 109-113, the examiner has not pointed to any teaching in any cited reference of "[a] method for preventing fouling of equipment during solvent recovery in a diene plant comprising treating a solvent recovery blend comprising at least one fouling agent with N,N-disubstituted amide." The examiner has not pointed to "close prior art," and the phrases are not indefinite, for the reasons just discussed. Applicant respectfully requests that the rejection based on the word "about" be withdrawn.

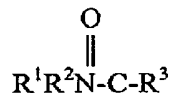
Rejections Under 35 U.S.C. § 103(a)

The examiner rejected claims 1-14 as obvious over Hollis (S.African ZA 6805343), Ferm (4,410,419) or Stanley (3,666,656).

Response

Claims 1-14 have been canceled and new claims 79-108 have been added in their place. Claim 79 is the broadest of claims 79-108.

Claim 79 is directed to a method for preventing fouling of equipment handling at least one fouling agent comprising treating a non-aqueous blend comprising the fouling agent(s) with N,N-disubstituted amide. The N,N-disubstituted amide has the following general formula:



wherein "R³" is selected from the group consisting of a combination of tall oil fatty acids comprising rosin acid, aryl groups, alkaryl groups, and aralkyl groups."

In order to establish that the claims are *prima facie* obvious over the cited references, the examiner must point to two things in the cited references, and not in the Applicant's disclosure-- (1) the suggestion of the invention, and (2) the expectation of its success. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). See also MPEP 2143. The examiner has not met this burden, for reasons discussed in more detail below.

The examiner cannot establish *prima facie* obviousness by merely arguing that the claimed method could be derived by modifying a cited reference to incorporate something not taught or suggested by the reference, itself, or by another cited reference. In order to establish *prima facie* obviousness, the examiner has the burden to point to a teaching or suggestion in the **references themselves** that it would be desirable to make such a modification. MPEP 2143.01; *In re Brouwer*, 37 U.S.P.Q.2d 1663, 1666 (Fed. Cir. 1995).

The examiner has not pointed to a teaching or suggestion that would motivate a person of ordinary skill in the art to make the modifications that would be required to result in a method for inhibiting fouling using the claimed N,N-disubstituted amide, comprising the claimed R³, as an antifouling agent. The examiner therefore has not established a case of *prima facie* obviousness of claims 79-108 over the cited references.

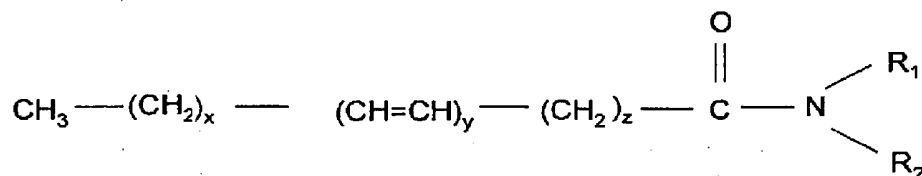
-Hollis

Hollis describes "[c]ontrol of scale in aqueous systems." Claims 1-14 have been canceled, and new claims 79-108 clarify that the blend treated is a "non-aqueous" blend. The examiner has not pointed to a teaching or suggestion that would motivate a person of ordinary

skill in the art to use Hollis' scale prevention compound to prevent fouling of equipment in non-aqueous systems. The examiner therefore has not established a case of *prima facie* obviousness of claims 79-108 over Hollis. Applicant respectfully requests that the rejection based on Hollis be withdrawn.

-Ferm

Ferm describes a process for reducing heat exchanger fouling using a dialkyl fatty acid amide having the following formula:



wherein

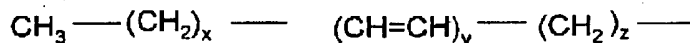
X and Z are independently integers from 0 to 12 and X+Z is at least 4,

Y is an integer from 0 to 3, and

R₁ and R₂ are independently alkyl groups of 1 to 6 carbon atoms, or taken together with amide nitrogen form a 5 to 6 membered heterocyclic ring.

Col. 1, l. 45-50.

The moiety:



from Ferm's structure corresponds to "R³" in the claims. In the pending claims, "R³" is selected from the group consisting of a combination of tall oil fatty acids comprising rosin acid, aryl

groups, alkaryl groups, and aralkyl groups.” The examiner does not contend that the claims are anticipated by Ferm. The examiner has not pointed to a teaching or suggestion that would motivate a person of ordinary skill to modify Ferm to result in the use of the claimed fouling agents. Applicant respectfully requests that the rejection based on Ferm be withdrawn.

-Stanley

Stanley teaches the use of an “oil-soluble **addition type copolymer**” (col. 1, ll. 69-70) to prevent fouling. In Stanley, monomeric components including certain dialkyl amides are “admixed in suitable proportions and polymerized” (col. 2, l. 73). Assuming for purposes of argument only that the claimed structure reads on Stanley’s monomer(s) (which Applicant does not admit), the examiner has not pointed to a teaching or suggestion in Stanley to use the monomeric components to inhibit fouling.

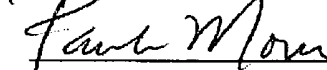
The examiner has not pointed to a teaching or suggestion of the claimed method in Stanley. Nor has the examiner pointed to a teaching or suggestion that would motivate a person of ordinary skill in the art to modify Stanley in the manner required to result in the claimed method. The examiner therefore has not established a case of *prima facie* obviousness of claims 79-108 over Stanley. Applicant respectfully requests that the rejection based on Stanley be withdrawn.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests entry of the attached amendments and allowance of the pending claims. The Commissioner is hereby authorized to

charge any fees in connection with this paper, or to credit any overpayment, to Deposit Account No. 02-0429 maintained by Baker Hughes Incorporated.

Respectfully submitted,



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